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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/764,554	01/18/2001	Juan Carlos Parodi	BSI-320US1	1961

7590 07/02/2002

RATNER & PRESTIA
Suite 301
One Westlakes (Berwyn)
P.O. Box 980
Valley Forge, PA 19482-0980

EXAMINER

MILLER, CHERYL L

ART UNIT PAPER NUMBER

3738

DATE MAILED: 07/02/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/764,554

Applicant(s)

PARODI, JUAN CARLOS

Examiner

Cheryl L. Miller

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 January 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>3</u> . | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. Claim 8 recites the limitation "The stent graft device" in line 1. There is insufficient antecedent basis for this limitation in the claim. It is suggested to change "The stent graft device" to recite --The endoluminal device--. Claims 9-11 recite "The device of claim 7" and it is also suggested to change the phrase to recite --The endoluminal device of claim 7--, in order to maintain consistency.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 7, 9, 10, 12 and 13 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 4, 5, 7, and 8 respectively of U.S. Patent No. 6,238,432 B1). Although the conflicting claims are not identical, they are not patentably distinct from each other because the application claim is merely broader than the patent claim. Once applicant has received a patent for a species or a more specific embodiment, he is not entitled to a patent

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for the generic or broader invention. The patented claim "anticipates" the application claim. *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993).

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

7. Claims 7-9, and 11-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Martin (USPN 5,575,817, cited in applicant's IDS). Martin discloses an endoluminal device and method for treating a lumen (col.1, lines 35-41; col.4, 1-35) substantially as claimed. See figure 1 and 4 and respective portions of the specification. Martin discloses a proximal main tubular portion (6) having a first diameter, two tubular limbs (4), (2), having a second diameter, wherein the distal ends of the limbs have a third diameter larger than the second diameter (area near (12)). Martin has shown in Fig. 1, a concave transition from the second diameter to the third diameter.

8. Claims 7-13 are rejected under 35 U.S.C. 102(e) as being anticipated by Kugler et al. (USPN 6,129,756). Kugler discloses an endoluminal device and method of treating a lumen (col.2, lines 30-45) substantially as claimed. See figure 2 and respective portions of the specification. Kugler discloses a

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proximal main tubular portion (10) having a first diameter, two tubular limbs (20), (30), having a second diameter, wherein the distal ends of the limbs (near (22) and (32)) have a third diameter larger than the second diameter (col.5, lines 25-31; col.9, lines 8-17; col.10, lines 26-42). Kugler has shown in Fig.2, a concave transition from the second diameter to the third diameter (col.9, lines 8-17).

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Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

USPN 5,476,506 to Lunn discloses a graft endoluminal device for a diseased aneurysm having enlarged ends in order to prevent kinking that would normally occur in a cylindrical graft, the features disclosed related to claims 7-11 and 13.

USPN 6,149,682 to Frid discloses a bifurcated graft having tapers made anywhere along the graft in order to reduce stress, change velocity and prevent thrombosis.

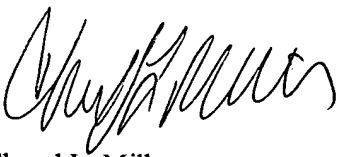
USPN 5,755,779 to Horiguchi discloses a concave taper on a graft in order to reduce pressure, increase velocity and prevent thickening of the lumen wall, the features disclosed related to claims 7 and 13.

USPN 6,306,164 to Kujawski discloses a bifurcated endoluminal device having 3 different diameters, a restriction area above the aneurysm, wherein a smallest diameter of the device is located here, having features related to claims 7-13.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl L. Miller whose telephone number is (703) 305-2812. The examiner can normally be reached on Monday through Friday from 7:30am to 5:00pm.

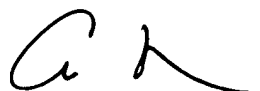
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached on (703) 308-2111. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3590.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.



Cheryl L. Miller

06/26/2002



CORRINE McDERMOTT
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700